

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-13 are now present in this application. Claims 1, 5 and 13 are independent. Claims 5-12 have been withdrawn from consideration. By this Amendment, claim 1 is amended and claim 13 added. No new matter is involved. Basis for the amendments to claim 1, including the frictional contact feature, is found throughout Applicants' originally filed patent application. Basis for new claim 13 is found, for example, in originally filed claim 1 and in the paragraph bridging pages 7 and 8 of the main body of Applicants' specification.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority documents.

Information Disclosure Citation

Applicants hereby inform the Examiner that an Information Disclosure Statement was filed on February 17, 2006 and respectfully request that the Examiner consider it prior to the next Office Action and provide Applicants with an initialed copy of the PTO-1449 form filed therewith, in the next Office Action.

Restriction/Election of Species Requirement

The Examiner has made the Restriction/Election of Species Requirement final, and has withdrawn claims 5-12 from further consideration. Applicants will cancel these claims upon an indication of allowable subject matter, reserving the right to present them in a continuing, e.g., divisional, patent application

Drawing Objection

The drawings have been objected to because of a discrepancy between stopper number labels in Figs. 3, 4 and 5. Applicants have amended Figs. 3 and 4 to make them consistent with Fig. 5 with regard to stopper number labels.

Reconsideration and withdrawal of this objection are respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 1 stands rejected under 35 USC §112, second paragraph, for being vague and indefinite. This rejection is respectfully traversed.

The Office Action states that the terminology “selectively adhered to the inner surface of the cylinder” is unclear.

Applicants respectfully submit that the meaning of the terminology in issue is clear. Nevertheless, in the interest of expediting prosecution of this application, Applicants have amended claim 1 to remove the objectionable language and have replaced it with the language that does not narrow the scope of the claim but is believed to be clear and definite. Basis for the amended language is found in Applicants' originally filed specification, e.g., on pages 6-8.

Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,593,977 to Hanh. This rejection is respectfully traversed.

Hanh does not anticipate claim 1, as amended, for a number of reasons. Firstly, Hahn's oil is not a movable structural member, as recited.

Secondly, Hahn does not disclose a unitary guide structural member located between the piston and the cylinder provided with an internal coupling hole to which an insertion portion of the rod member is coupled at a center thereof in order to attenuate vibration according to a width size of vibration transferred to a tub by multi-stage, and provided with first and second grooves at an outer circumferential surface thereof facing the cylinder, as recited. Actually, Hahn merely discloses a dashpot with separate chambers formed by separate elements.

Thirdly, Hahn does not disclose a movable damping structural member up and down movably fitted into the second groove and selectively to come into and out of frictional contact with the inner surface of the cylinder, as recited.

Accordingly, claim 1 is not anticipated by Hahn. Reconsideration and withdrawal of this rejection of claim 1 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,264,014 to Ferlicca. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). This burden can be satisfied when the PTO presents evidence, by means of some teaching, suggestion or inference either in the applied prior art or generally available knowledge, that would have appeared to have suggested the claimed subject matter to a person of ordinary skill in the art or would have motivated a person of ordinary skill in the art to combine the applied references in the proposed manner to arrive at the claimed invention. See Carella v. Starlight Archery Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); In re Rinehart, 531 F.2d 1048, 1051-1052, 189 USPQ 143, 147 (CCPA 1976).

If the PTO fails to meet this burden, then the applicants is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on

the entirety of the record, by a preponderance of evidence and weight of argument, In re Ochiai,
cited above.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the examiner, inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

What is alleged to be inherent must necessarily occur. The mere fact that something *may* result from a given set of circumstances is not sufficient. In re Oelrich, 212 USPQ 323, 326 (CCPA 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention

as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office Action must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Ferlicca does not disclose or suggest a number of positively recited features of the claimed invention including, for example, a unitary guide structural member located between the piston and the cylinder provided with an internal coupling hole to which an insertion portion of the rod member is coupled at a center thereof in order to attenuate vibration according to a width size of vibration transferred to a tub by multi-stage, and provided with first and second grooves at an outer circumferential surface thereof facing the cylinder, as recited. Actually, Ferlicca merely

discloses a single friction damper 5 with a single groove holding frictional element 7 that rubs up against the expanded cylinder wall.

Nor does Ferlicca disclose or suggest a movable damping structural member up and down movably fitted into the second groove and selectively to come into and out of frictional contact with the inner surface of the cylinder, as recited.

The statement that one of ordinary skill in the art would readily foresee the fixed member having additional supporting members is nothing more than speculation and it is well settled that a rejection may not properly be based on speculation, as noted in the case law cited above.

Accordingly, the Office Action has not made out a *prima facie* case of obviousness of the claimed invention by Ferlicca.

Reconsideration and withdrawal of this rejection of claims 1 and 2 are respectfully requested.

Claims 1, 2 and 4 stand rejected under 35 USC §103(a) as unpatentable over EP 0301190 to Bauer in view of Ferlicca. This rejection is respectfully traversed.

Bauer's unitary element 24 that faces the interior of the cylinder clearly has only one groove facing the interior wall of the cylinder and only has a single frictional element 30 fit therein. Thus, Bauer does not disclose the claimed (1) unitary guide member located between the piston and the cylinder provided with an internal coupling hole to which an insertion portion of the rod member is coupled at a center thereof in order to attenuate vibration according to a width size of vibration transferred to a tub by multi-stage, and provided with first and second grooves at an outer

circumferential surface thereof facing the cylinder; or (2) movable damping structural member up and down movably fitted into the second groove and selectively to come into and out of frictional contact with the inner surface of the cylinder.

Ferlicca does not disclose either of these features, either. So, even if one of ordinary skill in the art were motivated to modify Bauer in view of Ferlicca, the resulting modification of Bauer would neither meet nor render obvious the claimed invention.

Furthermore, the Office Action does not provide objective factual evidence that Bauer needs to be modified to work properly or why one of ordinary skill in the art would be motivated to modify Bauer in any way whatsoever. Additionally, the Office Action does not explain how Bauer is to be modified to result in the claimed invention, nor is it clear what aspect of Bauer is to be modified or how it is to be modified.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention in view of Bauer and Ferlicca.

Reconsideration and withdrawal of this rejection of claims 1, 2 and 4 are respectfully requested.

New Claim 13

Applicants have added claim 13, which positively recites a combination of features that is neither disclosed, nor suggested, by the art applied in the rejection of claims 1-4. For example, claim 13 positively recites a combination of features including a movable damping member up and down movably fitted into the second groove, adhered to the inner surface of the cylinder in case that the width size of vibration transferred to the tub is relatively less and movably contacted to the inner

surface of the cylinder for sliding by the stopper in case that the width size of vibration transferred to the tub is relatively great.

Accordingly, Applicants respectfully submit that new claim 13 patentably defines over the applied art.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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Attachments: Drawing Replacement sheet and Annotated Drawing Sheet showing Changes

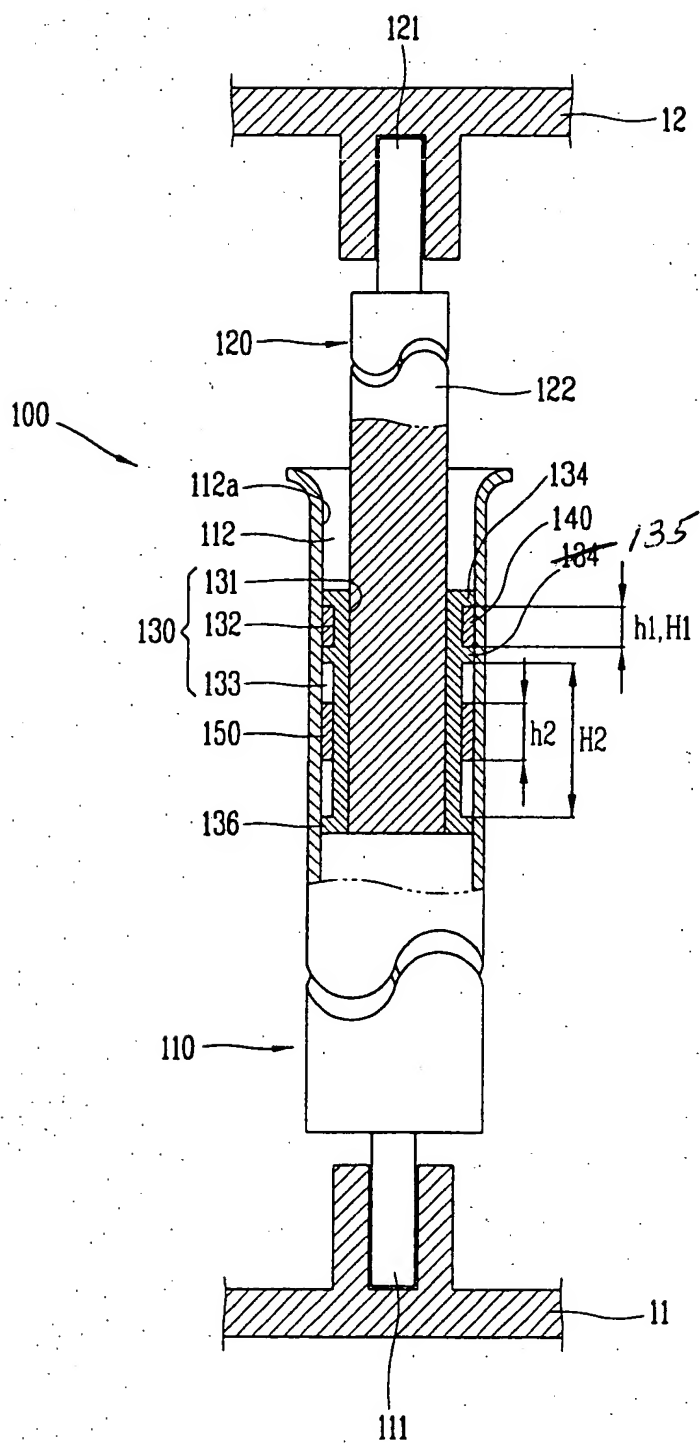
AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Figs. 3 and 4. These sheets, which include Figs. 3 and 4, replace the original sheets including those same Figures.

DESCRIBE CHANGE: Stopper labels have been amended to be consistent throughout Figs. 3, 4 and 5.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

FIG. 3



AMENDED SHEET
FIG. 4

